

## **REMARKS**

Claims 21-39 are amended advance prosecution. The Response After Final is limited to advance prosecution and to address any errors or mistakes that may be present.

### **New Matter and 35 U.S.C. §112**

Claims 21-39 have been objected to under 35 U.S.C. §132(a) as introducing new matter by using the terms: "a single spin outcome" and "the single spin outcome." Claims 21-39 have been further rejected under 35 U.S.C. §112 (first paragraph) for not mentioning these terms in the specification.

The word "single" is not used in the specification, but repeatedly through out the specification the following is used: "the outcome" (page 3, lines 24-25 and line 27); "the outcome" (page 4, line 18); "the reels stop" (page 5, line 5); "a matrix of symbols" (page 5, line 11); "a reel-stop position" (page 7, line 15); "this spin result" (page 8, line 19 and line 20); "this spin" (page 9, line 9); "this outcome" (page 9, lines 12-13); "displaying a matrix of symbols" (originally filed claims). The figures illustrate each of the above.

The undersigned, based on the Examiner's comment in the 1/7/05 Office Action, amended the claims to recite "single spin outcome." It is maintained that each of the above references and the figures fully support the use of the word "single" and that this does not constitute new matter. However, to advance prosecution, the use of the word "single" is removed. These amendments comply with the Examiner's requirement, but is certainly not an admission that the references set forth in the above paragraph have any other meaning than to provide a single spin outcome when the reels stop to provide a matrix of symbols as fully discussed and as shown in the figures. A person skilled in the art would also understand the above discussion to be a "single" spin outcome. These amendments overcome the 35 USC 112 rejection.

Evidence of the skill in the art is found in the Bennett reference at column 1, lines 29-45, column 3, lines 60-65, column 4, lines 8-14, Figure 3 and column 5, lines 43-46.

The preamble in each independent claim has been amended, so as to advance prosecution, to recite: "A method for operating a casino slot machine to a reel stop position having a spin outcome displaying a matrix of symbols having a plurality of pay lines in response to a wager on all of the plurality of pay lines received from a player." None of this is new matter,

all terminology used is found in the specification, and the preamble states what is conventional to a game outcome comprising a display of a matrix of symbols in the single spin of multi-reels, multi-pay lines in response to a wager received from a player.

### **New Drawing**

New amended Figure 7 has been requested and is herein submitted. No new matter has been introduced.

At the outset, it is maintained that there is no requirement that drawings "must show every feature of the invention specified in the claim" as that is the requirement of the written description. However, the drawings have been amended and are submitted herein to meet the objection. It is maintained that every feature is now shown. For example, claim 21 has every feature shown in Figure 7.

With respect to amended Figure 7, a new box 705 is provided such that when the at least one trigger symbol is provided, the player is alerted of the selectable wild feature. This is not new matter as it is fully presented on page 8 the fourth line of the last paragraph. This paragraph has been amended to recite that this alert feature appears in Figure 7, step 705. As a result of adding step 705, step 706 has been amended appropriately. The other language added to the existing features are found throughout the specification. Hence, no new matter has been added.

With respect to claim 29, claim 29 further includes the feature of converting the trigger symbol to a wild symbol. This has been added in to Figure 7 in dotted lines as step 709. This does not constitute new matter as it is fully discussed in paragraph [0038] of the specification.

With respect to independent claim 34, Figure 7, step 706 fully supports that the player can select any one of the displayed symbols including the trigger symbol which is found in paragraph [0040] of the specification. With respect to independent claim 35, the feature of a trigger symbol randomly appearing (and not limited to appearing in the display matrix) is fully supported in added step 705.

It is maintained that each independent claim has the features found therein fully supported in all of the drawings especially Figure 7 as amended. The objection and rejection are each overcome with amended Figure 7. It is to be understood that the drawing need not set forth each and every detail that appears in the written specification. It is also to be understood

that under patent law that the written specification need only provide sufficient information for one skilled in the art to practice the invention as claimed, which this application including the specification, drawings and claims accomplishes.

**Bennett 35 U.S.C. §102(e)**

Claims 21, 23, 27, 28, 34-36, 38 and 39 are rejected based on Bennett (6,648,758). It is respectfully maintained that the Rejection mistakenly interprets the teachings of Bennett.

Bennett provides a spinning reel base game that the players plays (column 3, lines 66-67). When a trigger combination of symbols appear in the outcome of the base game, a feature game is played by the player (column 4, lines 2-4). The base game and the feature game are different games with the feature game being themed (column 4, lines 8-17). Bennett refers to the feature game as a "bonus game" because it is a different and a separate game (column 4, line 5). Not only is the feature bonus game a separate game, but the player is given choices that affect the feature game play (column 4, lines 18-21). There are two crucial mistakes in the Made Final Rejection that must be addressed.

The claimed invention provides "the player with a touch input on any one of the remaining displayed symbols in the matrix of symbols of the spin outcome, other than the trigger symbol (claim 21) so as to enhance his/her winning combinations in the base reel game by selecting a wild symbol in the symbols displayed in the matrix of the casino slot machine. The player in the claimed invention does this "so as to obtain any winning combinations having higher corresponding awards based on the pay table than found in the single spin outcome" (claim 21). The first crucial mistake, it is respectfully maintained, is in the interpretation of Bennett and Bennett has no such disclosure. There is nothing the player can do in Bennett to change the base game outcome! The player in Bennett chooses only to affect separate play of the bonus feature game which occurs next and whose outcome is a separate bonus game outcome.

It is further respectfully maintained that the next crucial mistake made in the Rejection concerns what the Bennett player selects. In Bennett's Figure 3, the base game outcome is shown. The appearance of the two wild symbols is of no benefit to the player in the winning combinations of the base game outcome. **Nor, can the player accomplish anything by touching these two wild symbols!** The appearance of wild symbols is the trigger to play the

bonus game and the screen **automatically changes** (from Figure 3 to Figure 4) (column 5, lines 49-53). At this point, the player is given various options on how to play the bonus game (none of which affect the base game outcome). **The game outcome in Figure 3 is gone and never comes back.** The player selects an option in Figure 4 and then the first (of many) spin outcomes are displayed using the player selected option such as is shown in Figure 5. Note that the player selected option results in five Queens in pay line no. 1 and that the pay table award is multiplied by 10 (column 5, line 67). This crucial mistake on how Bennett operates could not be more clear than by observing that the spin outcome in Figure 5 is entirely different than the spin outcome in Figure 3. And, Bennett requires an intervening display (Figure 4) to allow the player to select an option. Everything that occurs in the claimed invention occurs in the displayed spin outcome in the base game. Bennett does not disclose the claimed invention nor would the claimed invention been obvious.

As fully illustrated and discussed in the application, claim 21 clearly recites that, in response to a wager on all of the plurality of pay lines a spin outcome randomly displays a matrix of symbols on a touch screen. When a trigger symbol is displayed in the spin outcome, the player is alerted that he/she is qualified to play a "wild selectable feature." The casino game receives a touch input from the player "on any one of the remaining displayed symbols in the matrix of symbols of the spin outcome, other than the trigger symbol." The touched symbol is converted to a wild symbol on the matrix of symbols of the spin outcome. The player is awarded for any winning symbol combinations based on a pay table in the matrix of symbols of the single spin outcome. This also occurs on the "spin outcome." Bennett does not disclose this under §102(e), nor is there any teachings in Bennett under §103. The same claimed features are found in the remaining independent claims 29, 34 and 35.

### **35 U.S.C. §103(a) Rejections**

For the reasons set forth above with respect to claim 21, when claim 24 is read with claim 21, claim 24 is patentable over Bennett.

Claims 22, 25, 26, and 29-33 are rejected under 35 U.S.C. §103(a) based on Bennett in view of O'Halloran.

For the reasons set forth above with respect to Bennett, and with respect to claims 22, 25, and 26, these claims are allowable as independent claim 21 is patentably distinct over

Bennett. With respect to claims 29-33, the same features found in independent claim 21 are found in independent claim 29 with the addition of automatically converting the trigger symbol to a wild symbol. Hence, it is maintained that claims 29-33 are patentably distinct over Bennett. O'Halloran does not provide any of the teachings with respect to the independent claim 29 as discussed with respect to independent claim 21 and hence all of these claims are patentably distinct.

Claim 37 is rejected based on Bennett in view of Stupak. Again, the arguments set forth with respect to independent claim 35 as set forth above are incorporated herein by reference. When dependent claim 37 is read into independent claim 35, it is patentably distinct over Bennett. Stupak provides no teachings with respect to independent claim 35 and hence claim 37 is patentably distinct over Bennett in view of Stupak.

Stupak has no relevance to the teachings of the independent claim and only teachings paying an award for multiple successive losses with either player wagering on the sequence of losses or adjusting probability of a win based on a number of successive losses. O'Halloran teaches that a wild symbol appears and then alters one or more other symbols to create additional winning opportunities. Neither Stupak or O'Halloran teaches, suggests, or infers that the player has any control whatsoever over a spin outcome as fully taught in each of the independent claims of the present invention.

Because of what is respectfully maintained to be mistakes in the interpretation of Bennett, the undersigned would respectfully request an oral teleconference with the undersigned and the inventor, if the Primary Examiner believes such a teleconference would advance the prosecution of this case. It is maintained that all claims are in condition for allowance and such allowance is respectfully requested.

Should you have any questions regarding the above, please feel free to give the below-listed attorney a call. If additional fees are required, please debit our Deposit Account No. 04-1414.

Respectfully submitted,

DORR, CARSON, SLOAN, BIRNEY & KRAMER, P.C.

Date: 8/16/05

By: 

Robert C. Dorr  
Reg. No. 27,782  
3010 East 6th Avenue  
Denver, Colorado 80206  
(303) 333-3010

C:\DOCS\Patent\Mikohn\357 - After Final Response